

m-L



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,404	12/01/2000	Satoshi Nishikawa	862.C2066	1364

5514 7590 09/25/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

QIN, YIXING

ART UNIT	PAPER NUMBER
----------	--------------

2625

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,404

Applicant(s)

NISHIKAWA, SATOSHI

Examiner

Yixing Qin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 and 27-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to applicant's amendment received 5/2/06, all requested changes have been entered.

Response to Arguments

Applicant's arguments filed 5/2/06 have been fully considered but they are not persuasive. The argument is that the applicant's invention is different from the Shima et al invention because the applicant's invention comprises a controller that is separate from the printer. Item 7 of Fig. 2 of Shima et al is a print controller for Shima et al's invention. This controller 7 is clearly separated from the print engine portion 11 of the printer, even though both the controller 7 and the print engine 11 are housed together. Nevertheless, Shima et al also discloses in column 14, lines 58-65 that a similar system can be created with a control in a print server, which is what the applicant's invention is doing. Please see the rejection below for more detail.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

I. Claims 6-9, 11, 27-30, 32-35, and 37-40 rejected under 35 U.S.C. 102(e) as being anticipated by Shima et al (U.S. Patent No. 6,104,498).

Regarding claims 6, 27, 32 and 37, Shima et al discloses a print control apparatus as a host computer, which is connected to a printing apparatus through an interface and which generates print data described in the page description language (Fig. 10, item 72 shows a job language interpretation task) to be interpreted by the printing apparatus (Fig. 2 and column 14, lines 58-65), comprising:

a spooler that saves data to be printed, which is issued from an application, together with a designated number of copies of a document to be printed based on the saved data; (Fig. 7 and column 8, lines 30-33)

a spool file manager that checks if a print instruction is a test print instruction, that changes the number of copies to 1 when the test print is instructed, and that outputs the data to be printed saved in the spooler together with the number of copies of documents to be printed in response to the print instruction for printing at the print apparatus; (Fig. 14, S95-S101 and column 14, lines 18-46; also see Fig. 12 that shows the print management task 74 - especially S59 and S60 - and column 13, line 66 - column 14, line 4)

a generation unit that reads the saved data to be printed with the number of copies of documents to be outputted by said spool file manager and generates the print data; (Fig. 14 , item S100) and

a transmission unit that transmit the data generated by said generation unit to the printing apparatus, (Fig. 2, item 9)

wherein when a test print is instructed, the said generation unit generates the print data which is described in the page description language with the number of copies which is has been changed into 1 for a test print when print of the document is instructed after the print data for the test print generated by said generating unit has been transmitted to the printing apparatus, said generating unit reads the data to be printed saved by the spooler and generates the print data which is described in the page description language. (Fig. 14 S100, which takes place after steps S95, S97 and S98 that indicate that a print job is a test print. Print information is then converted in S100 and printed)

Regarding claims 7, 28, 33 and 38, Shima et al discloses wherein when the print instruction is not the test print instruction, said spool file manager deletes the output data from said spooler. (Fig. 14 S96 and column 14, lines 23-25)

Regarding claims 8, 29, 34 and 39, Shima et al discloses wherein when the print instruction is the test print instruction, said generation unit generates the print data with a number of copies having a value obtained by subtracting the number of copies output in a test print process from the designated number of copies after said spool file manager outputs the data. (Fig. 14, S97 and column 14, lines 25-29)

Regarding claims 9, 30, 35 and 40, Shima et al discloses wherein the data stored in said spooler is intermediate data (Fig. 7) before being converted into a format to be output to the printing apparatus, and when the print instruction is the test print instruction, said spool file manager changes a setup associated with the data saved in said spooler after said spool file manager outputs the data. (column 14, lines 25-29).

Regarding claim 11, Shima et al discloses a print system which is constructed by connecting a print control apparatus of claim 6 and a printing apparatus and prints based on data output from output step of said print control apparatus. (Fig. 2)

II. Claims 10, 31, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498) in view of Williams et al (U.S. Patent No. 5,237,923).

Regarding claims 10, 31, 36 and 41, Shima et al discloses wherein said spool file manager changes the number of copies associated with the data saved in said spooler after said spool file manager outputs the data when the print instruction is the test print instruction, (Fig. 14 S97 and column 14, lines 25-29)

It does not explicitly disclose "resets the number of copies to the designated number of copies when the print instruction is not the test print instruction and when the number of copies has been changed."

However, the secondary reference by Williams et al teaches in column 8, lines 61-68 and column 9 line 3, the printing of "proof copies of the original document, the number being determined by the operator's instructions entered via keyboard..." and when "...acceptable, the operator can instruct the press to print the required number of final copies." Also, Williams et al takes into account that "[i]f changes are required, new printing plates can be made..." The point here is that Williams et al's reference accounts for changes in "proof" (test) copies and the ability to change the number of copies to any value based on user input.

Shima et al and Williams et al are combinable because both are in the art of printing multiple copies.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a step of resetting the number of copies to a designated value when test printing is involved as taught by the Williams et al reference in light of the Shima et al invention

The motivation would have been to be able to print the appropriate number of copies if the test print is deemed to be acceptable.

Therefore, it would have been obvious to combine Shima et al and Williams et al to obtain the invention as specified.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YQ


TWYLER LAMB
SUPERVISORY PATENT EXAMINER